

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-6, 8-24 and 26-43 are pending in the present application. Claims 1, 20 and 32-34 are amended in the present amendment.

Claim amendments find support in the claims as originally filed. Thus, no new matter is added.

In the outstanding Office Action, Claim 33 is rejected under 35 U.S.C. §112, second paragraph; Claims 1-6, 8, 9, 12-14, 16-24, 26, 27, and 30-43 were rejected under 25 U.S.C. 103(a) as unpatentable over Van Hees alone or in view of Kajander et al. (U.S. Pat. No. 6,723,670, herein "Kajander"); and Claims 10, 11, 28 and 29 were rejected under 35 U.S.C. §103(a) as unpatentable over Van Hees, Kajander in further view of Finley (U.S. Pat. No. 5,578,363).

With regard to the rejection of Claim 33 under 35 U.S.C. §112, second paragraph, Claim 33 has been amended to recite "placing the material, without adhesive bonding, into the floor base." Accordingly, Applicants respectfully request that the rejection of Claim 33 under 35 U.S.C. §112, second paragraph, be withdrawn.

In regard to the prior art rejections of the claims, the rejection of Claims 1-6, 8, 9, 12-14, 16-24, 26, 27, and 30-43 under §103(a) as unpatentable over Van Hees alone or in view of Kajander is respectfully traversed. Claim 1, recites,

an assembly comprising:
a wood floor directly above and in contact with a material comprising a felt of mineral fibers, the material comprising a felt of mineral fibers configured to attenuate a noise of an impact with the wood floor emitted in a same room as the wood floor,
wherein the felt includes binder that is in an amount from 3 to 30% by weight.

Claims 20, 32 and 34 recite similar features.

Van Hees describes a glass fiber mat used for sound insulation of a floating slab. Further Van Hees describes that the floating slab or screed is made of cement.¹ Additionally, Van Hees describes that a waterproof material is inserted between the insulating material and the floating slab in order to protect the material from the moisture of the cement.²

Kajander describes a glass fiber mat having a 20 +/- 3 percent by weight of binder.

However, neither Van Hees nor Kajander describes an assembly in which a wood floor is placed directly above and in contact with a material comprising a felt of mineral fibers, as is recited in Claim 1.

The outstanding Office Action takes the position that the floating screed of Van Hees is equivalent to the wood floor recited in Claim 1. Applicants disagree with this position because it is clear that Van Hees describes that the floating screed must be separated from the mat by a waterproof material. Clearly, Van Hees directly teaches away from the present invention because Van Hees describes that a waterproof material must be inserted between the insulating material and the floating slab in order to protect the material from the moisture of the wet cement of the floating slab. The assertion that Van Hees is not limited to floors made of concrete at the top of page 3 of the outstanding Action is clearly a conclusion *not* based on the disclosure of Van Hees.

In addition, the material recited in Claim 1 is specifically designed to attenuate the noise of an impact with a wood floor emitted in the same room as the wood floor. The noise produced by an impact with the floating screed or concrete described in Van Hees is not the "drum sound" produced by a wood floor. Thus, the concrete slab or screed of Van Hees is not equivalent to the wood floor recited in Claim 1. The undocumented conclusion that because wood and concrete are both hard they make the same sound when walked on is just that - an

¹ Van Hees, page 1, line 23.

² Van Hees, page 3, lines 4-16.

undocumented conclusion like those prohibited by the court in In re Lee, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

Further, neither Van Hees nor Kajander describes a material comprising a felt of mineral fibers configured to attenuate a noise of an impact with the wood floor emitted in a same room as the wood floor, as is recited in Claim 1.

The outstanding Office Action states on pages 11-12 that “it is inherent that the mat would attenuate the sound created in the room, as the mat is placed under the flooring for the purpose of sound attenuation, and the noise is created as the floor is walked on, and the mat of Van Hees is structurally and functionally equivalent to the claimed mat.”

However, Applicants respectfully traverse this assertion and respectfully point out that the mat of Van Hees is specifically designed to limit sound from passing through the flooring into a room below. In contrast, the material recited in Claim 1 is designed to limit the sound attenuated in the same room by a wood floor. In other words, the unique sound produced by impact with a wood floor (a sound not created with a concrete floor as known to all who have walked on a concrete floor) needs to be attenuated using a specific type of material. This material is specifically configured to attenuate the “drum sound” created by wood floors. The mat described in Van Hees would not provide this feature. Thus, the mat of Van Hees is not structurally and functionally equivalent to the claimed material.

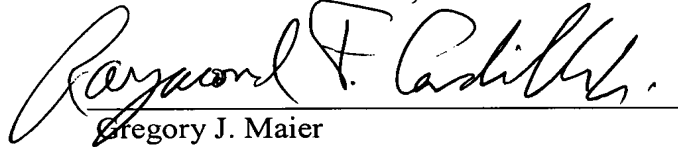
Moreover, the outstanding Action makes reference to “design choice.” However, the mat and wood floor arrangement claimed produces the advantage noted above and thus the doctrine of “design choice” does not apply.

Accordingly, in light of the above discussion, Applicants respectfully submit that Claims 1, 32 and 34 and claims depending therefrom patentably distinguish over Van Hees and Kajander considered alone or in any proper combination.

Consequently, in light of the above discussion and in view of the present amendment, the application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Gregory J. Maier", is written over a horizontal line.

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